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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,403	03/26/2004	Donald Edward Putzig	CH2973	1351

23906 7590 09/16/2005

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EXAMINER

BROWN, JENNINE M

ART UNIT PAPER NUMBER

1755

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/810,403	<b>Applicant(s)</b> PUTZIG, DONALD EDWARD	
	<b>Examiner</b> Jennine M. Brown	<b>Art Unit</b> 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-35 and 37-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-35 and 37-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/21/05</u> . | 6) <input type="checkbox"/> Other: _____  |

***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 3/26/04 was considered by the examiner.

***Response to Arguments***

Applicant's arguments filed 6/29/05, with respect to the rejections of claims 1, 3-20, 22-35, 37-50 under Jeon, et al. (US 6342579) in view of Kakizawa (US 5844066) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration and new search, a new grounds of rejection is made in view of copending 10/459244, US 6541598 B2, US 6489433 B2 and US 6232427 B1.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15, 32 and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15, 32 and 45 contains the trademark/trade name TYZOR® LA. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used

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properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe titanium bis ammonium lactate and, accordingly, the identification/description is indefinite.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-20, 22-35, 37-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Duan, et al. (US 6541598 B2).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in

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the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Duan, et al. disclose a composition comprising titanium (col. 2, l. 47-col. 3, l. 8), phosphorus containing ester is a phosphite ester (sodium pyrophosphite; col. 4, l. 40-41), hypophosphorous acid compound (col. 5, l. 57-col. 6, l. 10), optional zinc catalyst (col. 5, l. 7-12), cobalt aluminum cocatalyst (col. 6, l. 56-64), orthosilicate promoter (col. 5, l. 31-56), glycol (col. 6, l. 22-27), organic acid ester (col. 7, l. 22-64). Duan, et al. disclose processes for making the composition as well as methods for making fibers, filaments and esterification catalysts (col. 10, l. 12-col. 20, l. 34).

Claims 1, 3-20, 22-35, 37-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Duan, et al. (US 6489433 B2).

Duan, et al. disclose a composition comprising titanium (col. 2, l. 42-col. 3, l. 4), phosphorus containing ester is a phosphite ester (sodium pyrophosphite; col. 4, l. 16-45), hypophosphorous acid compound (col. 3, l. 39-47; col. 5, l. 53-col. 6, l. 6), optional zirconium catalyst (col. 3, l. 5-15), zinc or cobalt aluminum cocatalyst (col. 5, l. 4-9), orthosilicate promoter (col. 5, l. 27-52), lactic acid (col. 3, l. 24-30), organic acid ester (col. 7, l. 19-61). Duan, et al. disclose processes for making the composition as well as methods for making fibers, filaments and esterification catalysts (col. 10, l. 48-col. 19, l. 59).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 20, 22-35, 37-50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-34 of US Patent 6541598 B2.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim a method of using a composition with the same components as disclosed in the previous rejection. The instant claims would be a species of the previously patented claims because more specific phosphite esters are used. It would have been obvious to one of ordinary skill in the art to vary the composition claimed by changing from phosphate esters to phosphite esters because there would be less chance of deactivating the catalyst components by having available OH groups. "The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages", *In re Peterson* 65 USPQ 2d 1379 (CAFC 2003).

Claims 1, 3-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of US Patent 6489433 B2.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim a composition with the same components as disclosed in the previous rejection. The instant claims would be a species of the previously patented claims because more specific phosphite esters are used. It would have been obvious to one of ordinary skill in the art to vary the composition claimed by changing from phosphate esters to phosphite esters because there would be less chance of deactivating the catalyst components by having available OH groups. "The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages", *In re Peterson* 65 USPQ 2d 1379 (CAFC 2003).

Claims 20-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3-20 and 24 of copending Application 10/459244. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim a process comprising contacting in the presence of a catalyst composition, a carbonyl compound

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with an alcohol wherein a titanium, two phosphorus sources (sodium pyrophosphate and phosphonic acid) and a carbonyl compound are contacted with a zirconium compound. Although the copending claims require a toner and the instant claims do not, the claim language is open. It would have been obvious to one of ordinary skill in the art to modify the copending process to delete the toner as required if making a non colored polymeric composition because the toner would cause the resultant composition to have a color.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennine M. Brown whose telephone number is (571) 272-1364. The examiner can normally be reached on M-R 9:30 AM - 7:30 PM; Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jmb

  
J. A. LORENZO  
SUPERVISORY PATENT EXAMINER